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10/775,027	02/08/2004	Yaron Mayer		6966
7590 YARON MAYER 21 AHAD HAAM ST. JERUSALEM, 92151 ISRAEL				
			EXAMINER PUENTE, EMERSON C	
			ART UNIT 2113	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/775,027

**Applicant(s)**

MAYER, YARON

**Examiner**

EMERSON C. PUENTE

**Art Unit**

2113

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 6-8, 10, 11, 13, 14, 29, 33-36, 43-45 and 48-51 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 2, 4, 6-8, 10, 11, 13, 14, 29, 33-36, 43-45 and 48-51 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 08 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-840)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is made Non-Final.

Claims 1,2,4,6-8,10,11,13,14,29,33-36,43-45 and 48-51 have been examined.

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority. It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following reasons:

The abstract has too many words. An abstract is described as a brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. Correction is required. See MPEP § 608.01(b).

The "Summary of Invention" section is neither a brief summary nor general statements of the invention. Only the nature and gist of the invention or the inventive concept should be set forth. See MPEP § 608.01(d).

The "Detailed Description" section fails to describe all the preferred embodiment(s) of the invention as required in 37 CFR 1.71. See MPEP § 608.01(g).

Correction is required. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

Claims 1,2,4,6-8,10,11,13,14,29,33-36,43-45 and 48-51 are objected to because of the following informalities:

The claims are replete with lack of antecedent problems. Some examples include: "the normal state" (see line 3 of claim 1), "the nonvolatile memory" (see line 5 of claim 1), "the background" (see line 6 of claim 1), "the user" (see line 7 of claims 1), "the desktop" (see line 12 of claims 1).

The claims are replete with the limitation "and/or". Examiner suggests amending the limitation to "or" as the limitation is interpreted in the alternative.

The claims are replete with grammatical problems. For example, the limitation "... thus in not affected ..." (see last line of claim 4) should be changed to "... thus is not affected: ...".

The claims are replete with improper claim form. Each claim should begins with a capital letter and ends with a period. See MPEP 608.01(m).

Appropriate correction is required.

Furthermore, claims 2,6-8,10,11,13,14,29,33-36,45 and 48-51, which recite a number of additional elements or limitations written in the alternative form, depend upon either claims 1 or 43, which also recite a number of additional elements or limitations written in the alternative form. Such claim construction results in an enormous numbers of "inventions" being recited in a small number of claims. To determine whether any of the claims are patentable, each of these inventions would have to be fully examined. As such, the dependent claims 2,6-8,10,11,13,14,29,33-36,45 and 48-51 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim 2,6-8,10,11,13,14,29,33-36,45 and 48-51 have not been further treated on the merits.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The instant application is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over copending Application No. 11/846591. Although the conflicting claims are not identical, they are not patentably distinct from each other. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 of US Patent Application No. 11/846591 contains every element of claim 1 of the instant application and as such anticipate claim 1 of the instant application. A later application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed.

Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

The instant application is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over copending Application No. 10/907274. Although the conflicting claims are not identical, they are not patentably distinct from each other. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 of US Patent Application No. 10/907274 contains every element of claim 1 of the instant application and as such anticipate claim 1 of the instant application. A later application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States



Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC  
(DECIDED: May 30, 2001).

The instant application is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over copending Application No. 11/382698. Although the conflicting claims are not identical, they are not patentably distinct from each other. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 of US Patent Application No. 11/382698 contains every element of claim 1 of the instant application and as such anticipate claim 1 of the instant application. A later application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2,4,6-8,10,11,13,14,29,33-36,43-45 and 48-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite a number of elements directed to different concepts combined in a single claim wherein only one of the elements is required by the claims. Each of the respective elements provides separate, unrelated improvements. For example, claim 1 recites resetting the OS without booting at all, which is directed to improving the startup of an OS, preventing snatching the focus while the system is typing, which is directed to improving of the desktop functionality, and an automatic rollback, which is directed to improving reliability. Such claim construction makes it impossible to determine the exact invention and to ascertain what the metes and bounds are set forth in the claims. If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. See *Morton Int 'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993).

Furthermore, the independent claims and many of the dependent claims are both written in the alternative form, resulting in a plethora of combinations which must be reviewed for patentability. For example, independent claim 1, which recites 7 elements

in alternative language, and dependent claim 6, which recites 5 elements in alternative language, would result in a total of 35 combinations ( $7 \times 5$ ) to be examined before one could determine patentability for just claim 6. The MPEP recites where, in view of the nature and scope of applicant's invention, applicant presents an unreasonable number of claims which are repetitious and multiplied, the net result of which is to confuse rather than to clarify, a rejection on undue multiplicity based on 35 U.S.C. 112, second paragraph, may be appropriate. As noted by the court in *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963), "applicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged. Such latitude, however, should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion.

The claims are also narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claims must be in one sentence form only.

The claims are replete with phrases "for example" and "such as" that renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). For some examples, see claim

29 and 48, which recite "for example" and claims 10, 33, 36, and 48, which recite "such as".

The claims include parentheses that render the claim indefinite because it is unclear whether the limitation(s) within parentheses are part of the claimed invention. For example: "(or path)" (see claim 43).

The claims are also indefinite as they are replete with lack of antecedent problems. See MPEP 2173.05(e).

With respect to claim 1, the claim recites:

the limitation "the OS"(see line 3 of claim). It is unclear whether or not the limitation is in reference to "Operating Systems" recited in the preamble.

the limitation "resetting of the OS into the normal state it would be in after a successful boot, without the need to boot at all" (see line 4 of claim). It is unclear as to how to reset the OS to a normal state without ever booting the OS. As understood by the examiner, if there is no boot, then the computer would be off and hence, the OS cannot be in the normal state.

the limitations "significantly slowing down" (see line 6 of claim), "as many programs as possible" (see line 13-14 of claim), and "so as not to adversely affect speed of access"(see line 18 of claim), which is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

the limitation "a boot" (see line 7 of claim). It is unclear whether or not the limitation is in reference to "boot" recited in line 4 of claim. If so, the limitation should be amended to "the boot". If not, the limitation needs to be amended to distinguish between the two.

the limitation "the boot" (see line 8 of claim), which lacks antecedent basis. It is unclear whether the limitation is in reference to the "boot" recited in line 4 or line 6 of claim.

the limitation "from snatching the focus while the user is typing" (see line 9 of claims). It is unclear as to what the other programs would be snatching focus from if not prevented.

the limitation "in another partition" (see line 12 of claim), without reciting a first partition. Prior to having a second or another partition, a first or initial partition should be recited.

the limitation "Independent access mechanism" (see lines 17 and 19 of claim). It is unclear as to what the access mechanism is independent of.

With respect to claim 43, the claim recites:

the limitation "the links" (see line 11 of claim), which lacks antecedent basis. It is unclear whether the limitation is in reference to "Internet pages" in line 11 of claim. If so, examiner suggests amending limitation to "the Internet pages".

the limitation "the document file" (see line 12 of claim), which lacks antecedent basis. It is unclear whether the limitation is in reference to "files" recited in lines 3 or 6 of claim or intended to recite "a document file".

the limitation "the actual Internet"(see line 13 of claim), which lacks antecedent basis. It is unclear whether the limitation is in reference to "Internet pages". If so, examiner suggests amending limitation to "the Internet pages".

the limitation "the document"(see line 14 of claim), which lacks antecedent basis. It is unclear whether the limitation is in reference to "document file" recited in line 12 of claim. If so, examiner suggests amending limitation to "the Internet pages".

the limitation "user has a choice about this"(see line 15 of claim), "leaves this as the default" (see line 19 of claim), and "if the user allows this by default or request this specifically" (see line 30 of claim). It is unclear what the term "this" is in reference to.

the limitation "(or path)" (see line 18 of claim), which is indefinite since it is not clear whether the limitation is part of the invention.

the limitation "the original file" (see line 22 of claim), which lacks antecedent basis. It is unclear whether the limitations are in reference to the "file" recited in line 28 of claim. If so, examiner suggest amending limitation to "the file".

the limitation "the associated local undo file"(see line 23 of claim), which lacks antecedent basis. It is unclear whether the limitations are in reference to the "another local file" recited in line 28 of claim. If so, examiner suggest amending limitation to "the another local file".

the limitation "instead of just character strings" (see line 26 of claim). It is unclear whether or not the "character strings" constitute as an option.

the limitation "other location commands" (see line 31 of claim). It is unclear because the term "other" implies a previous or initial location command has been mentioned, but claim does not describe one.

the limitation "this text" (see line 37 of claim), which lacks antecedent basis. It is unclear whether the limitation is in reference to "font color and/or font attribute" recited in line 36 of claim. If so, examiner suggests amending limitation to "the font color and/or font attribute".

the limitation "the new text" (see line 39 of claim) which lacks antecedent basis. It is unclear whether the limitation is in reference to "this text" or intended to recite "a new text".

the limitation "a word processor" (see line 40 of claim). It is unclear whether or not this is in reference to the word processor recited in line 2 of claim. If so, examiner suggests amending claim to "the word processor". Otherwise, examiner suggests amending limitation such that is distinguishes from the word processor in line 2 of claim.

With respect to claim 44, the claim recites:

the limitation "has other limitations"(see line 11 of claim), which is indefinite as elements are not positively claimed, leaving one to wonder what constitutes "other limitations".

the limitation "the problem"(see line 24 of claim), which lacks antecedent basis. It is unclear whether the limitation is in reference to the "crash" or intended to recite "a problem".

the limitation "the incomplete step" (see line 25 of claim), which lacks antecedent basis. It is unclear whether the limitation is in reference to the "step causes the crash" or intended to recite "an incomplete step".

the limitation "their name"(see last line of claim). It is unclear what "their" is in reference to.

Due to the confusion and uncertainty as to the proper interpretation of the limitations of the claims, it would not be proper to reject such claims on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **EMERSON C. PUENTE** whose telephone number is (571)272-3652. The examiner can normally be reached on 9-6 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Emerson C Puente/  
Primary Examiner, Art Unit 2113